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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,446	12/26/2001	Rick K. Southern	D9426	1727

7590                    07/02/2003

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[REDACTED] EXAMINER

DORSEY, DENNIS

ART UNIT	PAPER NUMBER
	3637

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/034,446	SOUTHERN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Dennis L Dorsey	3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 March 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3,5-10,12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,5-10,12 and 13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 April 2002 is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-7, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn Patent Number 2,860,385 in view of Sweet et al. Patent Number 5,830,549.

Cohn '385 teaches all the limitations of the above claims except the floorboards being at least three feet, adhesive being water resistant and impermeable, and specifically to clean, dry smooth, flatten, and low moisture the surface of the concrete floor. Cohn '385 teaches hardwood floorboards (12, column 1, lines 54-55), adhesively attached (10) to concrete floor surface (12) with no subflooring (column 1, lines 15-21), and making the finishing strips by proper woodworking machinery (column 1, lines 54-55) inherently provides top surface (16) with colors (natural colors of the wood) and a finish (rough finish or smoothed machined finish).

Cohn '385 further teaches the steps of preparing the floorboard away from the site of installation (column 1, lines 54-55), prepare the concrete surface (column 1, lines 59-61), applying adhesive (column 2, lines 32-33), placing floorboard (column 2, lines 34-35), and allowing the floorboard to set (column 2, lines 35-44).

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Sweet '549 teaches the use of water resistant and impermeable adhesive (column 6, lines 54-55) to glue solid wood planks up to five feet in length (column 4, lines 11-15) and various thicknesses directly to a concrete surface that has been cleaned and dust free (column 7, lines 2-5). It would have been obvious for one skilled in the art at the time the invention was made to supply floorboards of lengths at least five three and up to five feet as taught by Sweet '549 since it is held to be within the skill of a worker in the art to select floorboard lengths as a matter of obvious design choice.

It would have been obvious for one skilled in the art at the time the invention was made to modify the Cohn invention and use a water resistant adhesive as taught by Sweet '549 since it is held to be within the skill of a worker in the art to select a known material on the basis of its suitability for its intended use as a matter of obvious design choice to solve the problem of moisture being absorbed through the adhesive as disclosed by Cohn '385

It is held to well known in the art to prepare a floor surface to be clean and free of water to insure proper adhesion of an adhesive to added to the floor surface. It would have been obvious for one skilled in the art at the time the invention was made to prepare the surface of the concrete floor in the Cohn '385 reference since it is held to within the skill of a worker in the art to clean, dry, smooth, and make substantially flat a floor surface when adding an adhesive for securing flooring products to ensure a strong and proper adhesion of the flooring products.

3. Claims 8-9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn Patent Number 2,860,385 in view of Sweet Patent Number 5,830,549.

Cohn '385 as modified by Sweet '549 teaches all the limitations of the above claims as outlined in the above paragraphs except the nailing of the floorboards to the concrete floor. Sweet '549 further teaches that it is well known in the art to nail wood flooring strips to a subfloor (column 1, lines 8-11). It would have been obvious for one skilled in the art at the time the invention was made to further nail the floorboards as taught by Sweet '549 since it is held to within the skill of a worker in the art to strengthen the flooring connection.

***Response to Arguments***

4. Applicant's arguments with respect to claims 1-3, 5-10, and 12-13 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis L Dorsey whose telephone number is 703-306-9137. The examiner can normally be reached on Monday-Friday 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1020.

DLD  
June 27, 2003

LANNA MAI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

*Lannamae*